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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/014,202

Filing Date: November 13, 2001

Appellant(s): GUTTA, SRINIVAS

Yan Glickberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/26/2007 appealing from the Office action
mailed 03/07/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 1 and 3-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5 758 257 HER7 05-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz (US 5,758,257).

As per claims 1, 14, 17, 22 and 23, Herz teaches:

A computerized method for recommending one or more available items to a target user, comprising the steps of:

obtaining a history of selecting one or more available items by at least one third party (see column 5, lines 24-54);

partitioning a third party selection history into a plurality of clusters (see column 5, lines 24-54; col 49, lines 1-20). According to Applicant's specification (page 7), a partition is equivalent to a cluster. Herz teaches clustering (i.e. partitioning) the profiles of third party persons viewing history (col 38, lines 1-55) and combining the viewing profiles of

two or more customers, with equal or unequal weightings, so that the video programming with content profiles strictly within the overlap area of the combined customer profiles will be preferred" (col 49, lines 1-20)

wherein each cluster comprises a segment of tangible items that exhibit a characteristic similarity (see Herz column 34, lines 57-60; column 38, lines 10-15; col 49, lines 1-20), wherein each cluster contains items that are closer to the mean of the cluster than any other cluster from among the plurality of clusters (see column 12, lines 29-55; column 37, lines 34-60; column 38, lines 1-55),

modifying a target user's history of selecting said one or more available items with one or more third party clusters to produce a modified target user's history (see column 49, lines 1-20);

processing the modified target user's history to generate a target user profile, wherein the modified target user's history characterizes preferences of the target user as modified to reflect preferences of the third party (see column 49, lines 1-20);

generating a recommendation score for at least one of said available items (see column 5, lines 5-20) based on said target user's profile (see column 49, lines 1-20); and

displaying the recommendation score to the target user (see column 49, lines 1-20).

As per claims 3 and 16, Herz teaches:

The method of claim 1, wherein said obtaining step further comprises the step of receiving a user selection of one or more of said clusters of similar items (see column 5, lines 24-54).

As per claim 4, Herz teaches:

The method of claim 1, wherein said one or more items are programs (see column 5, lines 1-20).

As per claim 5, Herz teaches:

The method of claim 1, wherein said one or more items are content (see column 8, lines 20-25).

As per claim 6, Herz teaches:

The method of claim 1, wherein said one or more items are products (see column 47, lines 53-67).

As per claims 7 and 18, Herz_ teaches:

A computerized method for maintaining a user profile indicating preferences of a user, comprising the steps of:

partitioning a third party selection history into a plurality of clusters, wherein each cluster comprises a segment of tangible items that exhibit a characteristic similarity (see

column 34, lines 57-60; column 38, lines 10-15), wherein each cluster contains items that are closer to the mean of the cluster than any other cluster from among the plurality of clusters (see column 12, lines 29-55; column 38, lines 1-55); receiving a selection from said user of at least one of said clusters of similar items (see column 5, lines 24-54; column 49, lines 1-20); and modifying or updating said user profile using said user selected clusters (see column 6, lines 50-55; column 30, lines 10-25).

As per claims 8 and 19, Herz teaches:

The method of claim 7, wherein said user profile is associated with a program content recommender (see column 4, lines 32-57).

As per claims 9 and 20, Herz teaches:

The method of claim 8, wherein said user profile indicates viewing preferences of said user (see column 4, lines 40-47).

As per claims 10 and 21, Herz teaches:

The method of claim 7, wherein said step of updating said user profile further comprises the steps of updating a selection history of said user with items from said selected clusters and updating said user profile using said updated selection history (see column 6, lines 10-60).

As per claim 11, Herz teaches:

The method of claim 7, wherein said one or more items are programs (see column 5, lines 1-21).

As per claim 12, Herz teaches:

The method of claim 7, wherein said one or more items are content (see column 8, lines 12-22).

As per claim 13, Herz teaches:

The method of claim 7, wherein said one or more items are products (see column 47, lines 52-67).

As per claim 15, Herz teaches:

The system of claim 14, wherein said processor is further configured to partition said third party selection history into clusters containing similar items (see column 5, lines 24-54).

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 7-10 and 12-14 fail to meet the above requirements.

(10) Response to Argument

The Appellant argues in page 12 of the Brief that the Office has not established *prima facie* that Herz teaches "partitioning a third party selection history into a plurality of clusters". The Appellant argues that in Herz the term "clustering" means combining customer profiles of two or more customers and therefore, according to the Appellant, Herz is missing the limitation "partitioning a third party selection history into a plurality of clusters". The Appellant further argues in page 15 of the Brief that the word "partition" as used by the Office, is a noun meaning "one of the parts of a whole", and is never used, according to the Appellant, in that sense. Rather, the Appellant argues, that the Appellant passage uses the word "partitions", as a verb to indicate an act performed on a third party viewing history, resulting in clusters. Therefore, according to the Appellant, a cluster is a result of the act of partitioning and is therefore not an equivalent of the act

of partitioning". Furthermore, the Appellant argues in pages 15 and 18 of the Brief that it is believed that the Office mischaracterizes Appellant's specification as stating "a partition is equivalent to a cluster" in order to establish that the "clustering" used by Herz is equivalent to the claimed "partitioning" step, when according to the Appellant, Herz only teaches combining customers profiles. The Examiner answers that Appellant's specification defines the term "clustering" where it recites "According to another feature of the invention, the television programming recommender processes the third party viewing history into a clustered third party viewing history...the clustered third party viewing history contains a number of clustered of television programs (data points) that are similar to one another in some way. Thus, a given cluster corresponds to a particular segment of television programs from the third party viewing history exhibiting specific pattern. The third party viewing history is processed in accordance with the present invention to generate the clustered third party viewing history, with each clustered containing programs exhibiting some specific pattern. Thereafter, the user can select one or more clusters from the clustered third party viewing history to supplement or replace corresponding portions (clusters) of the user's own viewing history" (see Appellant's specification page 5, lines 12-33). Therefore, Appellant's "clustering" simply means "partitioning" a customer viewing profile into a plurality of customer viewing profiles, where each partition customer viewing profile exhibits a specific viewing history pattern. Herz teaches a system that partitions a customer viewing profile into a plurality of clusters by partitioning each customer profile into a plurality of customer profiles, where the plurality of customer profiles are representative of the customer's changing

preferences for the predetermined characteristics in accordance with time of the day and of the week (see Herz col 5, lines 22-55) Therefore, contrary to Appellant's argument Herz is not missing the limitation "partitioning a third party selection history into a plurality of clusters" and Herz is not only teaching combining customers profiles because Appellant's "clustering" is equivalent to "partitioning" and Herz partitions each customer profile into a plurality of customer profiles (Le. plurality of clusters), where each partition customer profile (i.e. cluster) contains programs exhibiting some specific pattern (i.e. predetermine characteristics).

Furthermore, the Appellant is arguing about limitations that are not stated or disclosed in the claims or the specification when the Appellant argues that the Appellant's passage uses the word "partitions", as a verb to indicate an act performed on a third party viewing history, resulting in clusters and never as a noun meaning "one of the parts of a whole" and that a cluster is a result of the act of partitioning and is therefore not an equivalent of the act of partitioning". Appellant's specification simply discloses creating a cluster customer profile by partitioning a customer profile into a plurality of cluster and that is exactly what Herz teaches. Therefore, contrary to Appellant's argument, Herz teaches Appellant's "clustering" limitation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Daniel Lastra
Patent Examiner
Art Unit 3688
December 1, 2008

/James W. Myhre/
Supervisory Patent Examiner
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Conferees:

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Appeals Practice Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below: